

REMARKS

I. Introduction

In response to the Office Action dated June 21, 2007, claims 4-7, 26-29 and 48-51 have been amended. Claims 1, 4-23, 26-45 and 48-66 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Objections to the 131 Declarations

Beginning on page 2, the Office Action objects to the previously submitted Declarations under 37 C.F.R. §1.131, and asserts that they are insufficient to overcome the prior art rejections.

A. Whether the Declarations Establish Conception

The Office Action asserts that the Declarations fail to establish conception.

MPEP 715.02 states that "[t]he 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed ..., in the sense that the claim as a whole reads on it." Moreover, MPEP 715.02 states that "[i]f the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient."

Applicant's attorney submits that the Exhibit attached to the Kowalski and Souza Declarations provides these facts. (It is noted that the Kowalski Declaration Exhibit is the same as the Souza Declaration Exhibit, but the Souza Declaration Exhibit is hand-labeled with page numbers, and thus this response refers to the page numbers of the Souza Declaration Exhibit.)

Consider independent claim 1, which is set forth below:

1. A computer-implemented method for identifying and distinguishing words contained within an electronic message, comprising the steps of:

(a) creating and reading electronic messages in an electronic messaging application performed by a computer, wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network, and the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message by performing the steps of:

(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry; and

(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein

the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.

(Independent claims 23 and 45 recite similar limitations, in apparatus and article formats.)

As noted in both the Kowalski and Souza Declarations, the Exhibit is a "Disclosure" document that was created and submitted to the IBM Intellectual Property Law Dept. prior to June 21, 2000 for the purposes of drafting and filing the above-identified patent application. The Exhibit itself comprises "facts" established by the Declarations, not "conclusions" as alleged by the Office Action. In this regard, these "facts" establish that that support for the elements of this claim can be found in the Exhibit.

For example, with regard to the limitation "(a) creating and reading electronic messages in an electronic messaging application performed by a computer," this limitation can be found in the Exhibit at the following bolded locations:

Exhibit: Page 7

The present invention is a method and system for easily identifying and distinguishing words contained within an e-mail message in order to convey significance to the recipient of the message **The present invention relates to creating and reading e-mail messages.**

Consequently, Applicant's attorney asserts that this limitation "maps" to the Exhibit submitted with the Kowalski and Souza Declarations, indicating that the Exhibit is evidence of conception of this limitation.

In another example, with regard to the limitation "the electronic messaging application identifies and distinguishes certain words that are contained within the electronic message," this limitation can be found in the Exhibit at the following bolded locations:

Exhibit: Page 7

The present invention is a method and system for easily identifying and distinguishing words contained within an e-mail message in order to convey significance to the recipient of the message The present invention relates to creating and reading e-mail messages.

* * *

Accordingly, what is needed is a system and method within e-mail programs that will minimize the time required to read e-mail messages by allowing certain words that are contained within the e-mail message to be quickly and easily identified and distinguished within the e-mail message from the rest of the words in the message. The system and method can be

available at the time the message is created by the author or at the time the message is read by the recipient, and the words are ones that either the author or recipient can determine should convey significance.

Consequently, Applicant's attorney asserts that this limitation "maps" to the Exhibit submitted with the Kowalski and Souza Declarations, indicating that the Exhibit is evidence of conception of this limitation.

In another example, with regard to the limitations "(1) comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry" and "(2) making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient," these limitations can be found in the Exhibit at the following location:

Exhibit: Page 8

High level description

To address the requirements described above, the present invention discloses a method that includes: collecting significant terms, locating those terms inside an e-mail message, and, within the message itself, distinguishing them from the other "non-significant" terms so that they can be quickly and easily identified. With this method:

1) E-mail authors define a set of terms (which can be words, proper names, invented words) that they want to be registered as significant terms. When finished composing an e-mail message, the authors invoke the invention which scans the e-mail message and locates the registered terms in the body of the message. For each occurrence of a registered term, the invention asks the author whether it should make that occurrence to appear distinct within the message.

and

2) E-mail recipients define a set of terms (which can be words, proper names, invented words) that they want to be registered as significant terms. When they open an e-mail message to be read, the recipients invoke the invention which scans the e-mail message, locates the registered terms in the body of the message, and makes the occurrences appear distinct within the message.

Flowchart

The following are flow charts illustrating preferred embodiments of the method described above, one for use by an e-mail author and the other for use by an e-mail recipient:

Exhibit Page 9

(Figure 1, for email author)

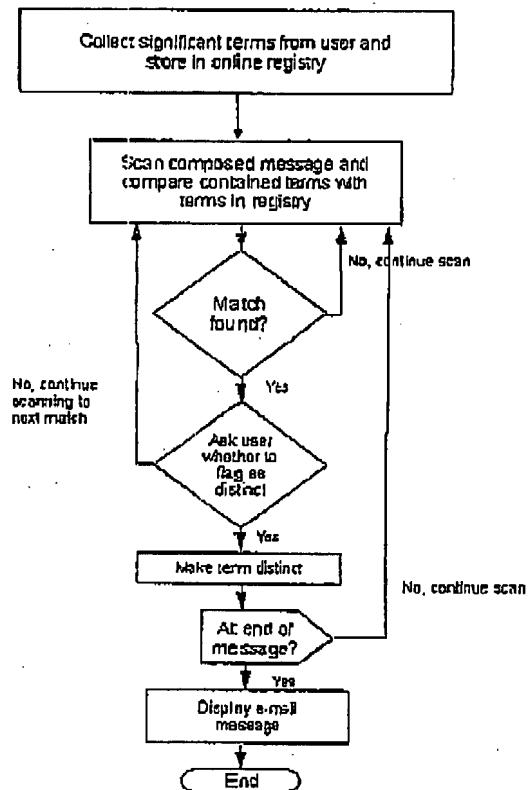
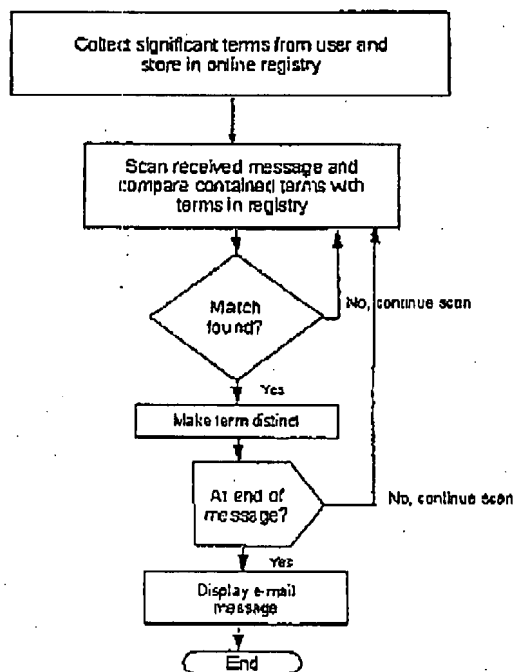


Exhibit: Page 10

(Figure 2, for email recipient)

Exhibit: Page 11**Example 1: Embodiments used by Authors of e-mail messages**

In the Lotus Notes e-mail product, provide an option off of the Edit menu named: "Collect key names/terms". This option would open a dialog where the user can select, type in, or otherwise specify terms of importance/significance; for example:

- Names of co-workers (could import these from the user's personal address book)
- Key product terms and names ("XYZ product", "Install Team", "Human Resources", etc.)

- Key words used in user's particular field ("XML", "HTML", etc.)

When the user is done in this dialog, a registry of these terms is built and kept on the user's machine.

Provide an option off of the Edit menu named: "Flag key names/terms". This option would be available when the user is composing a new e-mail message. This option would open a dialog similar to the spell-check window where the user can indicate that the embodiment of the invention should go through the e-mail message and flag in turn any term that matches any of the key names/terms that are in the registry collected earlier, or flag any names of people in the To: list that also appear in the body of the message. When a key

term is flagged, the user has the option in the dialog of specifying how to indicate that the term is significant; for example, make the term be a different font, make the term be a different color, add an image next to the term, attach a sound file on the term.

At the end of the process, the result is an e-mail message that has terms that are in different fonts and colors that signify to the recipients those places that they should pay attention to. Key names from the To: list are flagged in bright bold red at places where they have actions to do; different color for some people; bold font for status, install and build. Below, the author choose not to make bold every occurrence of "install" and "build"; just the ones where he thought it would make a difference:

Consequently, Applicant's attorney asserts that these limitations "map" to the Exhibit submitted with the Kowalski and Souza Declarations, indicating that the Exhibit is evidence of conception of this limitation.

In conclusion, Applicant's attorney submits that the above portions of the Exhibit fully support independent claim 1 (as well as independent claims 23 and 45). More specifically, Applicant's attorney submits that the above portions of the Exhibit prove that the Applicant possessed a complete conception of the invention prior to the effective date of the reference.

Applicant's attorney also notes that there is no requirement, in the MPEP, CFR or USC, that the Declarations themselves map the claim limitations to the Exhibit, and this requirement is asserted only by the Office Action itself without citation to any authority supporting the assertion. Applicant's attorney submits that the Exhibit itself provides the requisite facts, which anyone can objectively analyze, to satisfy a determination that the inventors had sufficient possession of the invention to establish a date of conception prior to critical date. Consequently, Applicant's attorney traverses the requirement that the Declarations themselves must map the claim limitations to the Exhibit.

Finally, with regard to dependent claims 4-23, 26-45 and 48-66, Applicant's attorney submits that these claims can also be mapped to the Exhibit, in the following manner:

<u>Claims</u>	<u>Found in Exhibit at:</u>
4, 26 and 48	Page 8, paragraph 8; and page 10
5, 27 and 49	Page 8, paragraph 6; and page 9
6, 28 and 50	Page 8, paragraph 8; and page 10
7, 29 and 51	Page 8, paragraph 6; and page 9

8, 30 and 52	Page 8, paragraphs 6 and 8; and page 9
9, 31 and 53	Page 8, paragraphs 6 and 8; and page 9
10, 32 and 54	Page 8, paragraphs 6 and 8; and page 9
11, 33 and 55	Page 11, paragraph 3
12, 34 and 56	Page 11, paragraph 3
13, 35 and 57	Page 11, paragraph 3
14, 36 and 58	Page 11, paragraph 3
15, 37 and 59	Page 11, paragraph 5
16, 38 and 60	Page 11, paragraph 5
17, 39 and 61	Page 11, paragraph 5
18, 40 and 62	Page 11, paragraph 5
19, 41 and 63	Page 11, paragraph 5
20, 42 and 64	Page 11, paragraphs 5 and 6
21, 43 and 65	Pages 9 and 10
22, 44 and 66	Page 8, paragraph 6

B. Whether the Declarations Establish Diligence

The Office Action also asserts that the Declarations fail to establish diligence.

Applicant's attorney disagrees.

In this situation, specific testimony and facts are provided by the Souza Declaration and its accompanying Exhibit comprising the "Disclosure" document regarding the diligence in the filing of the patent application, namely the following:

- (a) On page 5, the May 30, 2000 date that "[t]his evaluation was entered ..." under "Evaluation," which is the date that Souza entered the decision by the Patent Evaluation team regarding whether the "Disclosure" document should be filed as a patent application.
- (b) On page 5, the "Date rated" under "Team Evaluation," is May 30, 2000, which is the date that Souza entered the rating by the Patent Evaluation team for the "Disclosure" document, indicating that the invention was suitable for a "search" prior to filing as a patent application.

- (c) On page 5, the "Date sent" under "Search Information," is May 30, 2000, which is the date that Souza sent instructions to a searcher for a patentability search for the invention described in the "Disclosure" document.
- (d) On page 5, the "Ship/Return date" under "Search Office Information," is June 20, 2000, which is the date that Souza received the results of the patentability search from the searcher for the invention described in the "Disclosure" document.
- (e) On page 5, the "Date of Final Decision" date is May 8, 2001, which is the date that Souza entered the decision by the attorneys in the Intellectual Property Law Dept. of SVL to proceed with the filing of a patent application for the invention described in the "Disclosure" document.

The Souza Declaration states that the "Disclosure" document was handled in the normal manner for inventions processed by the Intellectual Property Law Dept. of SVL. The Souza Declaration also states that, during the time period between receipt of the search report on June 20, 2000 until instructions were sent to attorney George H. Gates on May 18, 2001, a normal backlog of unrelated cases were taken up in chronological order and carried out expeditiously. In addition, the Souza Declaration states that the assignee worked reasonably hard on the application during the period from June 20, 2000 until May 18, 2001. Finally, the Souza Declaration states that this entailed, among other things, reviewing the results of the patentability search with the inventor.

These are all "facts" attested to by the Souza Declaration. The Office Action's assertion that these statements comprise mere pleading and are not evidence is erroneous. Applicants' attorney notes that the Exhibit itself is evidence, as are the statements by the Souza Declaration interpreting the Exhibits and explaining the procedures of the Intellectual Property Law Dept. of SVL for the handling of applications. The statement in the Souza Declaration that the cases were worked on in chronological order is a fact, not a conclusion, as is the statement in the Souza Declaration that the Intellectual Property Law Dept. of SVL had a reasonable backlog of cases which the Intellectual Property Law Dept. of SVL carried out expeditiously.

Finally, the Office Action's assertion that the number of elapsed days in this situation are of critical important is erroneous. What is required is continuous and reasonable diligence toward reduction to practice, which is shown by the evidence submitted in this application. However, the period from conception to reduction to practice is irrelevant. See, e.g., *Wilson v. Sherts*, 81 F.2d 755, 28 USPQ 379 (CCPA 1936).

Applicant's attorney submits that the Declarations and their accompanying Exhibits show reasonable and continuous efforts involved in the constructive reduction to practice of the present application and thus comprise evidence of reasonable diligence. In light of these facts, Applicant's attorney submits that the Declarations provide sufficient evidence of a diligent reduction to practice.

Thus, Applicant's attorney submits that the Declarations under 37 C.F.R. §1.131 are sufficient to overcome the prior art rejections. Consequently, Applicant's attorney requests that these objections be withdrawn.

III. Claim Objections

On page (9) of the Office Action, claims 4-7, 26-29 and 48-51 were objected to because of certain informalities.

Applicant's attorney has amended the claims to overcome these objections.

IV. Prior Art Rejections

A. The Office Action Rejections

On page (10) of the Office Action, claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over "Special Edition Using Microsoft Outlook 2002" (Padwick) in view of U.S. Publication No. 2004/0080528 (Rand), and further in view of U.S. Patent No. 6,009,442 (Chen). On page (29) of the Office Action, claims 17, 18, 39, 40, 61 and 62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick, in view of Rand and Chen, and further in view of U.S. Publication No. 2003/0020749 (Abu-Hakima). On page (32) of the Office Action, claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick in view of Chen. On page (50) of the Office Action, claims 17, 18, 39, 40, 61 and 62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Padwick, in view of Chen, and further in view of U.S. Patent No. 5,825,854 (Larson).

Applicant's attorney submits that the previously-submitted Declaration under 37 C.F.R. §1.131 by inventor Lee Anne Kowalski and Declaration under 37 C.F.R. §1.131 by George H. Gates, supplemented by the Declaration under 37 C.F.R. §1.131 by Jeanette Berry Souza, taken together, eliminate Padwick, Rand and Abu-Hakima as references. Consequently, Applicant's attorney requests withdrawal of the rejections based on these references.

V. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

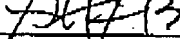
Respectfully submitted,

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